

REMARKS

By the present amendment, Applicant has amended Claim 12. Claims 12-20 remain pending in the present application. Claim 12 is the only independent claim.

In the recent Office Action the Examiner rejected Claims 12, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Pourdeyhimi et al. (US Patent Publication 2005/0034376). Claims 13, 15, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. (US Patent Publication 2005/0034376) in view of Dugan (US 3,855,132). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. (US Patent Publication 2005/0034376) in view of Dugan (US 3,855,132) for the same reasons as the rejection of Claim 13, and further in view of Etani (US 3,946,362). Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. (US Patent Publication 2005/0034376) in view of Dugan (US 3,855,132) for the same reasons as the rejection of Claim 17, and further in view of Hunt (US 5,103,601).

Applicant respectfully traverses these rejections. In this regard, Applicant has submitted herewith a declaration under 37 C.F.R. § 1.131 clearly establishing that the presently claimed invention was conceived and reduced to practice prior to the effective filing date of the Pourdeyhimi et al. U.S. Patent Publication Document, based on

Provisional Application No. 60/490,725, filed July 29, 2003, thereby rendering moot the use of the Pourdeyhimi et al. reference as prior art against the claimed invention. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 12, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Pourdeyhimi et al. Applicant further requests reconsideration and withdrawal of the rejections of Claims 13-15 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over a combination of references, Pourdeyhimi et al., Dugan, Etani and Hunt, wherein the Pourdeyhimi et al. reference is applied as the basic reference in each of the rejections.

Applicant further traverses the rejection of Claims 12, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Pourdeyhimi et al. In this regard, the Pourdeyhimi et al. reference discloses a filler or pack material that is porous, of low density, and may be cut and molded to fit in a gutter. Pourdeyhimi et al. recites that the filler “can easily [be] cut or molded into the right shape to pack a gutter. Fig. 1A illustrates a preferred embodiment of such a product 10, and Fig. 1B shows product 10 packed into a gutter G in accordance with the invention” (Pourdeyhimi et al., paragraph [0053], lines 3-7). And, in Claim 1, lines 9-12 Pourdeyhimi et al. recites: “said porous filler material is positioned in the roof gutter so as to substantially fill the roof gutter”. The Examiner’s attention is directed to Applicant’s amended Claim 1, which recites, in part: “*a substantially triangular-shaped void is defined between said angled side, said front wall and bottom*

wall of said gutter, whereby liquid may enter said gutter upper opening and travel through said filter insert into said void, for flow to a gutter liquid outlet while leaves and other debris are trapped on the upper side of said filter insert". A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). Since the Pourdeyhimi et al. reference teaches the filling or packing of the roof gutter, to "substantially fill" the roof gutter, Pourdeyhimi et al. would inherently be lacking in a triangular-shaped void between the filler and the front and bottom of the roof gutter for the flow of liquid, as is required by Applicant's Claim 1. Thus, since each and every element of the claimed invention is not shown in the prior art reference to Pourdeyhimi et al., the rejection under 35 U.S.C. § 102(e) is improper, and should be withdrawn.

The patents to Dugan, Etani and Hunt, cited and applied by the Examiner in his rejections of Claims 13-15 and 18-20 under 35 U.S.C. § 103(a), along with the other prior art references made of record but not applied, have been carefully reviewed, however Applicant finds nothing therein which would overcome or supply that which is lacking in the basic Pourdeyhimi et al. reference noted above. In this regard, none of the references disclose a substantially triangular shaped void between an angled side of a filter insert and

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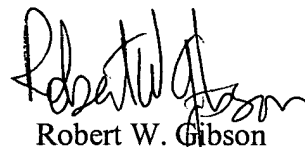
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the front and bottom walls of a gutter. Applicant is of the view that these references, taken alone or in combination, neither teach nor suggest Applicant's combined gutter and filter insert recited in the claims, and therefore fail to establish a *prima facie* case of obviousness.

The claims in this application have been revised to more particularly define applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,


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Attachments